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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,976	11/16/2001	J. Donald Hill	018880.0120	7910

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EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,976

Applicant(s)

HILL ET AL.

Examiner

Thomas C. Barrett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6-8 and 25-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12-15, 19-21, 42 and 43 is/are rejected.
- 7) ☒ Claim(s) 9-11, 16-18, 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-2, 12-13, 15, 19-20 and 43 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argues:

"Reif does not disclose that sutures may be secured between threads 40 and 47. Moreover, Applicants maintain that any attempt to secure fixing sutures between threads 40 and 47 would interfere with the correct mating of the male tapered thread 40 with the female tapered thread 47, contrary to the express teaching of Reif. Further, attempting to secure fixing sutures between threads 40 and 47 would twist and pull the sutures as the threading mechanism is tightened" (Id. at Line 40) and could damage the replacement valve, the sutures, or the threads of the Reif's stiffening ring. Therefore, Applicants maintain that in view of this amendment, claims 1, 19, and 20 are distinguished over Reif."

Even if the cited prior art does not work as well as the presently claimed invention, as long as it is **capable** of fixing sutures, even poorly, it meets the claimed structural limitations.

Regarding withdrawn claims 3, 14 and 42, the Examiner has rejoined these claims because they were improperly restricted. The subspecies of claims 3, 14 and 42 are obvious variants of claims 2, 13 and 43 respectively. The Examiner withdrew claim 42 because it corresponded to claims 3 and 14, which were not elected by the Applicant. This was an apparent oversight by the Applicant because claims 3 and 14 were not shown as reading on any species listed in the restriction response of December 10, 2003.

Claim Objections

Claims 42 and 43 are objected to because of the following informalities: the terminology is inconsistent with the prior claims, causing confusion. It is requested that the amend the claim such that the "first cylinder" of claims 42 and 43 is the same as the "first cylinder" of claims 1-3, 12-15 and 19-20, i.e. the "first cylinder" is the interior cylinder. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 12-15, 19-21 and 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (5,766,240). Johnson discloses an apparatus comprising: a first cylinder (120) having first and second ends, the second end having an adjacent exterior annular lip (120.1) for securing to an interior groove (130.6) on a second cylinder (130). Johnson also discloses an apparatus comprising: a first cylinder having first and second ends, the second end having an adjacent exterior annular groove for securing to an interior lip on a second cylinder (Figs. 7 and 8). The first cylinder has a fabric annular cuff surrounding the exterior surface adjacent the first end. The first and second securing means of Johnson are **capable** of "fixing sutures therebetween", and therefore meet the structural limitations.

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Allowable Subject Matter

Claims 9-11, 16-18 and 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Barrett